

Application No.: 09/897861

Case No.: 54396US011

Remarks

Election/Restriction

Applicant affirms the elections of Claims 2, 15 and 21 drawn to a mold, classified in class 425, subclass 363 with traverse.

The Applicant submits that having a different classification alone is not a sufficient basis for the restriction. The Applicant submits that claim 19 is a dependent claim of claim 15 and thus if the mold of claim 15 is found patentable, then an article produced by the mold is also patentable. Similarly, claim 20 shares the same feature as claim 15, in that the seam/joining line has a width of 0.0025 mm to about 0.2 mm on the patterned side. Accordingly, if this feature is found to be a patentable distinction with regard to claim 15, then the same feature is also a patentable distinction with regard to claim 20 in the context of an article made from such mold, i.e. having a seam corresponding to the joining line of the mold.

Rejections under 35 U.S.C. § 103

Claims 2, 15 and 21 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Raley (4,155,693.)

U.S. Patent No. 6,322,652, to which the present application claims priority, claims

1. A method of making a tooling, comprising the steps of:
providing a substantially planar tooling having a first end and a second end opposing one another, a patterned side, and a back side opposite the patterned side;
placing the opposing ends together to form a substantially cylindrical shape forming a lumen therein, wherein the back side faces the lumen; and
welding the ends together only from the lumen such that at least the opposing ends of the back side are joined with less than 100% penetration of a resulting weld.

In view of using this unique process of welding, the patterned side does not have a weld per se, but rather a joining line of the ends of the tooling. Since the patterned side is not welded the joining line has a surprisingly small width, i.e. 0.0025 mm to about 0.2 mm. (See Fig. 16)

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Other methods of welding, result in a relatively wide weld line, rather than a joining line. (See for example Fig. 3-5.)

Accordingly to the MPEP 706.02(j), to establish a prima facie case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second there must be reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

The Applicant submits that a mold comprises a joining line having a width of about 0.0025 mm to about 0.2 mm on the patterned side is not a trivial feature, but rather results by employing certain welding techniques as described in Applicant's application. The cited reference fails to describe Applicant's welding techniques. Further, there is no suggestion or motivation in the reference nor in the knowledge generally available to one of ordinary skill in the art to modify the reference to arrive at the presently claimed invention.

The Applicant has responded to all the rejections set forth by the Examiner. The Applicant respectfully requests withdrawal of the restriction requirement as well as withdrawal of the rejection under 35 U.S.C. 103 and a timely allowance of all the claims.

Respectfully submitted,

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Date

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